

REMARKS

Objection to Office Action Being Made Final

Applicants first note an objection to the examiner's decision to make this Office Action final. As stated in the MPEP, the examiner may reopen prosecution after appeal to enter a new ground of rejection. The examiner may make the Office Action final, however, only in two circumstances: (a) if necessitated by amendment, or (b) if based on information provided in an information disclosure statement. (See MPEP § 1207.04).

In the present Office Action, the examiner has claimed that the new ground of rejection was necessitated by Applicants' amendment. With respect, the examiner is plainly incorrect. Applicants entered an amendment in a response dated September 8, 2005. The examiner acknowledged that amendment in a Final Office Action dated November 30, 2005, which precipitated Applicants' notice of appeal and appeal brief. Applicants' appeal brief clearly states that there have been "no amendments after final rejection." (See Applicants' Amended Appeal Brief, at 3, 8/10/07). Consequently, the examiner's new ground of rejection could not have been necessitated by amendment because no such amendment occurred. The examiner therefore did not comply with MPEP § 1207.04 in making this Office Action final.

To the extent the examiner asserts that Applicants' September 8, 2005 amendment has necessitated the new ground of rejection, Applicants strongly object. The examiner has previously acknowledged the September 8, 2005 amendment and rejected Applicants' amended claims in a Final Office Action. The examiner failed to enter the present new ground of rejection at that time, and therefore tacitly admitted that Applicants' amendment did not necessitate the present rejection. The examiner cannot now reach past intervening events—including the examiner's own Final Office Action and Applicants' appeal—to claim that a nearly three-year-old amendment has necessitated this new ground of rejection.

Accordingly, because the examiner's new ground of rejection was not necessitated by amendment, the examiner failed to comply with MPEP § 1207.04. Applicants therefore respectfully request the examiner to issue a Non-Final Office Action in this reopened prosecution.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 4-7, 9-10, 12, 14-16, 23, 25, 46, and 62-69 are pending in the present application, with Claims 1 and 46 being independent. In the Office Action, the examiner rejected Claims 1, 4-7, 9-10, 12, 14-16, 23, 25, 46, and 62-69 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Application No. 2005/0027610 (hereinafter Wharton) in view of one or more of U.S. Patent Application No. 2003/0069922 (hereinafter Arunachalam) and U.S. Patent No. 5,878,141 (hereinafter Daly). Applicants respectfully traverse that rejection and request reconsideration.

Independent Claims

The proposed modification of Wharton in view of Arunachalam and Daly, either alone or in combination, lacks one or more limitations recited in each of independent claims 1 and 46 in at least the following respects.

- As acknowledged by the examiner, Wharton fails to teach or suggest transmitting order information to a check-out application of the merchant server by the transaction portal server and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the transaction portal server, and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation information by the transaction portal server on the display screen of the wireless communication device for the customer. Rather, Wharton discloses transmitting transaction packets from a vendor commerce system to the ICC transaction processor. When the customer in Wharton checks out, the ICC transaction processor engages one or more back-end processing functions, including verifying the merchant and customer, accounting and billing, and order fulfillment. (See, e.g., Wharton, paras. 0040-0053).
- Nor does Wharton teach or suggest retrieving default payment method information for the customer by the transaction portal server from an electronic wallet server. Rather, Wharton discloses prompting a customer for customer-

specific payment verification information, such as credit card information. (See, e.g., Wharton, paras. 0038-0042).

- Nor does Wharton teach or suggest a unique product and merchant identifying code entered by a customer on a wireless communication device. Rather, the customer in Wharton selects from vendors by clicking a hyperlink selection of a vendor and communicating directly with the merchant's server to conduct a local search and retrieval of the product stored in the merchant's local product catalog. (See, e.g., Wharton, paras. 0036-0038).
- Arunachalam fails to remedy the deficiencies of Wharton.
 - Rather than teach or suggest transmitting order information to a check-out application of the merchant server by the transaction portal server and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the transaction portal server, and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation information by the transaction portal server on the display screen of the wireless communication device for the customer, as recited in independent claims 1 and 46, Arunachalam teaches a purchasing transaction with a credit card featuring billing processing by a Visa node and a data source. (See, e.g., Arunachalam, para. 0095). Accordingly, Arunachalam does not involve completion of payment information by an electronic wallet server. Also, Arunachalam teaches arranging delivery via a FedEx node, using data supplied by the client. (See, e.g., Arunachalam, para. 0096). Again, an electronic wallet server does not provide the delivery information. Moreover, Arunachalam recites various nodes that process the checkout rather than the merchant's server.
 - Rather than teach or suggest retrieving default payment method information for the customer by the transaction portal server from an electronic wallet server, as recited in independent claims 1 and 46,

Arunachalam teaches a purchasing portion of a service transaction involving a “Visa node” for bill payment that is indicated by a client. (See, e.g., Arunachalam, paras. 0094-0095).

- And rather than teach or suggest a unique product and merchant identifying code entered by a customer on a wireless communication device, as recited in independent claims 1 and 46, Arunachalam teaches simply connecting to a service provider via a hub. (See, e.g., Arunachalam, para. 0094).
- Likewise, Daly fails to remedy the deficiencies of Wharton and Arunachalam.
 - Instead of transmitting order information to a check-out application of the merchant server by the transaction portal server and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the transaction portal server, and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation information by the transaction portal server on the display screen of the wireless communication device for the customer, as recited in claims 1 and 46, Daly teaches sending a purchase request from a purchasing terminal through a transaction processing unit, which gathers information related to the purchaser and the merchant. (See, e.g., Daly, Col. 7, ll. 1-25).
 - Rather than teach or suggest retrieving default payment method information for the customer by the transaction portal server from an electronic wallet server, as recited in independent claims 1 and 46, Daly discloses payment methods registered by the purchaser with a purchasing system and placed on a purchaser database. (See, e.g., Daly, Col. 5, ll. 49-52; Col. 7, ll. 54-56). Plainly, a purchaser database and an electronic wallet server are not the same thing.
 - Rather than teach or suggest a unique product and merchant identifying code entered by a customer on a wireless communication device, as

recited in independent claims 1 and 46, Daly discloses identifying the merchant itself. (See, e.g., Daly, Col. 7, ll. 3-5).

- Applicants further object to the examiner's conclusory assertion that it would have been obvious to one of ordinary skill in the art to include a unique product and merchant identifying code entered by a customer on a wireless communication device. To purchase a particular item, a purchaser must indeed identify the desired item, but this identification certainly need not be done with an identifying code. Nor would a code be obvious when purchases could be made by identifying a merchant and product by name or otherwise. Wharton and/or Arunachalam and/or Daly do not recite this limitation, and the examiner has not cited any other reference that does cite the limitation. Accordingly, the examiner's assertion of obviousness fails to remedy the deficiencies of the cited references.
- Finally, Applicants note that the examiner did not individually reject dependent claims 4-7, 9-10, 12, 14-16, 23, 25, and 62-69. The examiner's failure to provide individual reasons for rejecting each claim conflicts with the following statement from the MPEP: "The goal of examination is to *clearly articulate any rejection* early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." (MPEP § 706). Moreover, the MPEP requires each pending claim to be treated individually *and* for the examiner to summarize the status of all claims. (See MPEP § 707.07(i)). Accordingly, Applicants request individual consideration of all dependent claims.

Consequently, Wharton and/or Arunachalam and/or Daly, separately or in combination with one another, do not recite the required combination of limitations of independent claims 1 and 46. Because the cited references, either alone or in combination, do not teach the limitations of independent claims 1 and 46, the examiner has failed to establish the required *prima facie* case of unpatentability. See In re Royka, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim);

see also MPEP § 2143.03. Similarly, the examiner has failed to establish the required *prima facie* case of unpatentability for claims 4-7, 9-10, 12, 14-16, 23, 25, and 62-69, which depend from independent claims 1 and 46.

Summary

Thus, Applicants submit that independent Claims 1 and 46 are patentable over the documents cited by the examiner. Additionally, the remaining claims depend from one of the independent claims either directly or indirectly and are submitted to be patentable for similar reasons. The dependent claims also recite additional features further defining the present invention over the cited documents, and Applicants submit that the cited documents do not teach or suggest integrating those features into the presently claimed invention. Accordingly, Applicants request separate and individual consideration of each dependent claim.

Applicants have not addressed each specific rejection of the independent and dependent claims because Applicants submit that the independent claims are allowable over the documents of record, as discussed above. Applicants have not acquiesced to any such rejection and reserve the right to address the patentability of any additional claim features in the future.

CONCLUSION

Applicants submit the foregoing as a full and complete response to the Official Action dated November 16, 2007. Applicants submit that this Response places the application in condition for allowance and respectfully request such action. Applicants submit that the remarks provided above do not present any new issues for review by the examiner. If any issues exist that can be resolved with an examiner's Amendment or a telephone conference, please contact Applicants' undersigned attorney at the number listed below.

Respectfully submitted,

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